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In re Application of
Cowser, et al.
Application No. 09/715,983
Filed: November 20, 2000
Attorney Docket No. ISIS0057-100 (ISPH-0519)
FOR: ANTISENSE MODULATION OF PI3K P85
EXPRESSION

OFFICE OF PETITIONS

**DECISION DISMISSING
PETITION**

This is a decision on the petition entitled, "PETITION TO THE COMMISSIONER UNDER 37 CFR 1.182," filed November 10, 2003 (certificate of mailing date November 7, 2003), requesting refund of fees paid on November 7, 2003 in connection with the above-identified application. The petition will be treated under 37 CFR 1.181.

The petition under 37 CFR 1.181 is **DISMISSED**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.181." This is **not** final agency action within the meaning of 5 U.S.C. § 704.

A final Office action was mailed on May 7, 2003. On July 7, 2003 applicants filed an amendment after final that failed to place the application in *prima facie* condition for allowance, as was indicated in the July 30, 2003 Advisory Action. The Advisory Action indicated that amended claims 24, 26-28, 30, and 31 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s). Petitioners mailed an amendment to the Office on August 7, 2003 via Express Mail that canceled the non-allowed claims. On August 19, 2003, petitioners received a date stamped return receipt postcard from the Office citing August 7, 2003 as the date of receipt.

Petitioners allege that on November 6, 2003, a USPTO employee indicated that the Office had no record of receiving the August 7, 2003 amendment. Petitioners, filed a three month extension of time, another copy of the August 7, 2003 amendment, and a Notice of Appeal and required fee, based on the alleged advice of the USPTO employee. Petitioners contend that because the Office received the August 7, 2003 Amendment (a date stamped postcard receipt proves this fact) and that if the amendment had been entered, only allowable claims would have remained pending, that petitioners are due a refund. Petitioners request a refund of the fees paid on November 7,

2003 because they contend that the fees were paid due to error on the part of the USPTO.

Petitioners are reminded that the applicable statute, 35 USC 42(d), authorizes the Commissioner to refund "any fee paid by mistake or any amount paid in excess of that required." Thus the USPTO may refund: (1) a fee paid when no fee is required (*i.e.*, a fee paid by mistake), or (2) any fee paid in excess of the amount of the fee that is required. See Ex Parte Grady, 59 USPQ 276, 277 (Comm'r Pats. 1943) (the statutory authorization for the refund of fees is applicable only to a mistake relating to the fee payment, and not the underlying action). 37 CFR 1.26(a)

The extension of time fee and the Notice of Appeal fee were not fees paid when no fees were required, and were not fees paid in an amount in excess of that required. In order to be refundable, the mistake must clearly be in relation to the payment itself, and not the underlying action. Grady, supra. The amount paid herein was owed at the time it was paid.

The rules of practice are clear that prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. Petitioners purchased a three month extension of time and paid the Notice of Appeal fee as an insurance policy in case consideration of the August 7, 2003 Amendment did not result in the case being allowed. 37 CFR 1.116 and 1.135(b) are clear that proceedings concerning an amendment after final rejection will not operate to avoid abandonment of the application in the absence of a timely and proper appeal. Petitioners were acting as prudent practitioners when they purchased a three month extension of time and paid the Notice of Appeal fee. Such conscientious patent practice is not a mistake within the meaning of the aforementioned statute and regulation that warrants a refund.

Further correspondence with respect to this matter should be addressed as follows:

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Telephone inquiries concerning this decision should be directed to the undersigned at (703) 308-6712.

A handwritten signature in cursive script, appearing to read "E. Shirene Willis".

E. Shirene Willis
Senior Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy